

Appl. No. 10/689,910
Atty. Docket No. 9391
Amdt. dated 8/18/06
Reply to Office Action of 5/22/06
Customer No. 27752

REMARKS/ARGUMENTS

Claim 1 has been amended to recite the polyamide adsorbent of step (b), per original Claim 8 (now cancelled as redundant). Claims 1, 5 and 6 have also been amended to meet the rejections under §112, as discussed below. It is submitted that all amendments are fully supported and entry is requested.

Claims 1 – 3, 5 - 7, 9 and 10 are now under consideration. Claim 4 has also been cancelled as redundant in view of the amendments to Claim 1. Claims 11-20 were previously withdrawn from consideration. Applicants herewith affirm the election of Claims 1-10 for further prosecution, but without prejudice to their right to petition the affirmation of the Restriction Requirement (Office Action pages 2-3) with respect to Claims 11-20.

Rejections Under 35 USC 112

Claims 1-10 stand rejected under §112 for reasons of record at page 4 of the Office Action, specifically:

- i.) Claim 1 “the theanine extract” – this has been amended to recite “extract comprising theanine,” per step (a).
- ii.) Claim 5 “the theanine eluate” has been amended to recite “the extract comprising theanine,” per Claim 1.
- iii.) Claim 6, the “about” has been deleted.

It is submitted that the foregoing amendments meet all points of rejection raised by the Examiner. Withdrawal of all rejections under §112 is requested.

Rejections Under 35 USC 102

Claims 1-4, 9 and 10 stand rejected under §102 over EP 1057483 and over US 5,878,733, for reasons of record at pages 5-7 of the Office Action.

Applicants respectfully traverse all rejections under §102, to the extent they may be applied to the claims as now amended.

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At the outset, Applicants acknowledge the Examiner's thorough consideration and exposition of the teachings of the cited documents under both §102 and §103 (below). This extra effort by the Examiner allows the discussion herein to be relatively brief.

Before turning to the specific grounds of rejection under §102, attention is directed to the controlling law in this matter.

As stressed in MPEP §2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. (Citations omitted.) Moreover, "The identical invention must be shown in as complete detail as contained in the . . . claim." (*Ibid*; emphasis supplied)

Furthermore, not only must all the individual elements be found in a single document, but also they all must be arranged as in the claim under review. *In re Raymond G. Bond*, 910 F. 2d 831; 1990 US App. LEXIS 13087; 15 USPQ 2D (BNA) 1566 [cases cited at LEXIS document, page 2, II.]

Succinctly stated, neither EP '483 nor US '733 meets the foregoing tests to support any rejection under §102, with regard to the claims as now amended.

EP '483 relates to compositions comprising theanine, and various assertedly curative properties thereof. However, with regard to the preparation of the theanine, itself, (which, of course, is the subject of the present invention) the disclosures of '483 are rather sparse. At [0010] various, apparently known, methods are mentioned, but no details are given for the tea-leaves extraction process. Indeed, no literature reference for the extraction process appears at [0010], so the details of the process are unclear.

At page 6 of the Office Action, the Examiner cites [0052] of Ueda (which is EP '483) as teaching an extraction of tea leaves. In fact, [0052] of EP '483 relates to the preparation of theanine-containing candies. No extraction process is discussed. It is suggested that [0042] is the proper citation.

In any event, nothing in EP '483 relates to the use of polyamide adsorbent step [step (b) of the present invention] nor to the use of a nanofiltration step [step (c) of the present invention]. Accordingly, it is submitted that, absent these elements, '483 cannot support a rejection under §102, as a matter of law. Withdrawal of the rejections on this basis is requested.

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With regard to US '733, it is submitted that this document not only does not teach step (b) of the present process [adsorption using polyamide] but also teaches away from the use of polyamides in the overall process.

In this regard, the Examiner's attention is directed to column 9, lines 10-15, wherein the '733 patentees state:

However, polyamide (e.g., nylon) type polymers are usually unsuitable as membrane materials because the polymer from which the membrane is made has too great an affinity for the catechins and will thus remove or filter out too much of the desired components from the green tea extract.

In sharp contrast, the present process uses a polyamide adsorbent, followed by nanofiltration. Since the sequence of processing steps [extract → polyamide adsorbent → nanofiltration → theanine-rich extract] of the present invention is not taught by '733, it is submitted that the rejection under §102 is not supported, as a matter of law. Withdrawal of the rejections on this basis is therefore requested.

Rejections Under 35 USC 103

Claims 1-7 and 10 stand rejected over '733 in view of US 6,210,679, for reasons of record at pages 7-10 of the Office Action.

Claims 1-8 and 10 stand rejected over '733 and '679 in view of the Zhongyu article (English language abstract) and EP 1077211, for reasons of record at pages 10-12 of the Office Action.

Applicants respectfully traverse all grounds for rejection under §103, to the extent they may be applied to the claims as now amended.

In particular, Applicants assert that none of the cited documents, singly or in combination, support a *prima facie* conclusion of obviousness. Under MPEP 2142, the Examiner bears the burden of factually supporting any *prima facie* conclusion of obviousness. In determining the differences between the cited art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. See *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). If the Examiner does not prove a *prima*

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facie case of unpatentability, then without more, the Applicant is entitled to the grant of the patent. See in re *Oetiker*, 977 F.2d 1443.

To establish a *prima facie* case of obviousness under 35 USC §103, the Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the reference itself, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second there must be a reasonable expectation of success. Finally, the cited references must teach or suggest all the claim limitations. See, for example, *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Succinctly stated, none of the cited documents, taken singly or in the various combinations proposed by the Examiner, meets the foregoing tests to support any of the several rejections under §103, with regard to the claims as now amended.

Turning to the first grounds of rejection, as discussed above under §102, the primary reference US '733 quite clearly teaches away from the use of polyamide materials in its theanine enrichment process. This, of course, is the exact opposite of the present process, where a polyamide is expressly employed as an adsorbent prior to the nanofiltration step.

Moreover, US '679 is directed to the isolation of EGCG from tea, rather than theanine, so there is no basis for combining '679 with '733 to arrive at the present invention. Indeed, even if the documents were combinable, '733 still would teach away from the use of polyamides and, thus, the purported combination would still teach away from the present process as regards theanine. Said another way, the key document that relates to theanine enrichment teaches: Don't use polyamides; whereas polyamides are used in step (b) of the present process. Accordingly, reconsideration and withdrawal of the rejections on this basis are requested.

The self-same considerations hold true for the second grounds of §103 rejection ('733 and '679 in view of Zhongyu and EP 1,077,211). Again, '733 teaches against the use of polyamides in the isolation of theanine. The '679 disclosure pertains to EGCG isolation and has nothing to do with theanine. Thus, there is no motivation to combine '679 with '733. And, Zhongyu teaches adsorption onto polyamide – which is precisely what '733 avoids when isolating theanine. EP '211 (like US '679, above) also relates to EGCG production, so there is no rationale for using its disclosures to modify any of the other documents to arrive at the present process.

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In short, it is submitted that to combine the documents in the manner suggested by the Examiner flies in the face of the clear teachings of '733 with respect to the non-use of polyamides specifically when isolating theanine. It is further submitted that the "EGCG documents" US '679 and EP '211 cannot be used to modify this clear disclosure in '733. Accordingly, reconsideration and withdrawal of the rejections on this basis are requested.

In light of the foregoing, early and favorable action in the case is requested.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By


Jerry J. Yetter
Registration No. 26,598
(513) 627-2996

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Customer No. 27752